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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
WATKINS III, WILLIAM P	
ART UNIT	**PAPER NUMBER**
1772	

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/977,374	BAKKER, WILLIAM J.	
	Examiner	Art Unit	
	William P. Watkins III	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The rejections under 103 for obviousness given in the office action mailed 12 August 2003 have been withdrawn and are replaced by rejections using most of the same or the same references and applicant's admissions of record regarding the content of these references in an effort to further clarify the record and the position of the examiner. As there may be some change in emphasis in the rejections, they are treated as new grounds of rejection. Applicant's arguments regarding the previous grounds of rejection will be discussed below. A new obviousness type double patenting rejection is also given below.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 36, 37, 38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heilman et al.

(Australia 27,337) in view of Amberg et al. (U.S. 3,955,699) further in view of applicant's admissions in the amendment filed 17 February 2004 at page 13, last paragraph to page 14, second paragraph, in the reply brief filed 24 August 2000, page 2, 6th paragraph beginning "Once again", and in the supplemental appeal brief filed 12 May 2000 at pages 5 and 6).

Heilman et al. teach a film which extends over the rim of a container and is heat shrunk onto the container by applying energy which may be in the form of indirect infrared radiation to the edge first, in order to contract the film edge onto the rim of the container and form a seal. The top is shielded while the rim is shrunk, and as an option the top is then heated in order to contract and further tighten the film (page 10). The film may be transparent (page 3). The film of Heilman et al. being transparent, remains unchanged when exposed directly to infrared radiation, and is instead responsive to the heat generated by the infrared radiation when it strikes parts, of the oven or the container, that absorb the radiation and are heated (see applicant's arguments in the amendment, and briefs noted above). The examiner takes the above noted arguments by applicant as an admission that the film substrate of Heilman et al. remains unchanged upon exposure to radiant energy as is

instantly claimed. Amberg et al. teach using an opaque material made of an elongate blank or strip of a thermoplastic material to form a skirt on a lid edge that shrinks and forms a tight fit and seal with the container edge when the opaque plastic material is directly heated by infrared radiation. Using direct infrared radiation with an opaque material is taught as being advantageous because only a few IR lamps are needed for this direct exposure (col. 4, lines 45-50). The instant invention claims a means included on the downwardly extending portion of a film lid, that coverts radiant energy to heat, which in turn shrinks the downward edge portion of the film onto the rim of a container, to form a spill resistant cover on the container. As a matter of claim construction "the extending portion including a first means to convert the radiant energy to heat" is taken as the extending portion being a tinted material or having an energy absorbing coating, which may be colored and formed by printing (page 12, line 35 to page 13, line 25 of the instant specification) and their structural equivalents. It would have been obvious to one of ordinary skill in the art join an opaque heat shrinkable thermoplastic material to the downwardly extending edge portion of Heilman et al. or make the downwardly extending edge portion of an opaque heat shrinkable

thermoplastic material in order to directly absorb infrared radiation and use only a limited number of lamps because of the teachings of Amberg et al. Regarding claim 41, use of film in a roll to make lids is taught by Heilman et al. (see Figures 3 and 7). Regarding claim 38, the examiner takes the opaque portion of Heilman et al. in view of Amberg et al. and applicant's admissions, as having a tint or difference in color from the transparent central portion of the film.

4. Claims 39-40, 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heilman et al. (Australia 27,337) in view of Amberg et al. (U.S. 3,955,699) further in view of applicant's admissions in the amendment filed 17 February 2004 at page 13, last paragraph to page 14, second paragraph, in the reply brief filed 24 August 2000, page 2, 6th paragraph beginning "Once again", and in the supplemental appeal brief filed 12 May 2000 at pages 5 and 6) as applied to claims 36, 37, 38 and 41 above, and further in view of Anderson et al. (U.S. 5,113,479).

Anderson et al. teach the use of a dark color strip formed by printing on a portion of a thermoplastic film laminated to a cardboard or paper central layer, that is to be heated by direct

IR radiation till it softens so that it may be joined to a second thermoplastic film folded over the edge of the central layer (col. 3, lines 1-15). The dark color printed strip enhances the absorption of the IR radiation in order to reduce power consumption during the heating step (col. 3, lines 10-15). The instant invention claims the use of an opaque portion formed on the downwardly extending portion of a film lid by printing with an ink coating that absorbs IR radiation. It further would have been obvious make the downwardly extending portion of the film of Heilman et al. (Australia 27,337) in view of Amberg et al. (U.S. 3,955,699) further in view of applicant's admissions as noted above, better able to absorb IR radiation by the use of dark printing ink in order to reduce energy consumption because of the teachings of Anderson et al.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 36-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19, 1, 3, 4 and 5 of U.S. Patent 5,993,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in the language used to claim similar structures that function in the same manner to form film lid covers on containers. The "susceptor material" of the '942 patent (col. 8, lines 45-60 of the '942 patent) is equivalent in structure and function to the instant "first means to absorb radiant energy" (as constructed above). The claims of the instant application and the patent would therefore be obvious over one another to one of ordinary skill in the art despite slight differences in claim language scope.

7. Claims 36-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18, 21, 1, 3 and 4 of U.S. Patent No.

6,291,037. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in the language used to claim similar structures that function in the same manner to form film lid covers on containers. The "susceptor material" of the '037 patent (col. 8, lines 50-65 of the '942 patent) is equivalent in structure and function to the instant "first means to absorb radiant energy" (as constructed above). The claims of the instant application and the patent would therefore be obvious over one another to one of ordinary skill in the art despite slight differences in claim language scope.

8. Applicant's arguments filed 17 February 2004 have been considered but are not persuasive.

Applicant argues that Heilman et al. has no suggestion to make the extending portion of the film any different than the central portion and that Amberg et al. teaches a central portion that is not heat shrunk. The examiner relies on Amberg et al. to teach an extending portion that is different than the central portion and Heilman et al. to teach a central portion that can be heat shrunk. Modification of Heilman et al. does not destroy the function of Heilman et al. and is motivated by the energy

savings of fewer IF lamps taught by Amberg et al. Regarding Anderson applicant argues that layer 4 is not a thermoplastic but instead is cardboard. Web 4 is a continuous web material (col. 2, line 53), which is defined as a central paper or cardboard core laminated on both sides with thermoplastic (col. 1, lines 20-25). The IR light of Anderson thus is directed onto a thermoplastic film, which is softened and then joined to the thermoplastic film of edge 5.

Applicant further argues on page 10 of the amendment that Heilman does not teach a film material that is not unchanged upon exposure to radiation. The position of the examiner is that the above cited admissions of applicant contradict this argument. Applicant also argues that Anderson involves heating to soften a thermoplastic film and not heating to shrink a thermoplastic film. The examiner relies on the other references for the teaching of shrinking and Anderson et al. only for a method of increasing IR absorption, which is taught as a means of shrinking by Amberg et al. As Anderson et al. is in the film packaging art as are Amberg et al. and Heilman, the examiner is of the opinion that one of ordinary skill in the art would transfer the teaching of using dark printing on film from Anderson et al., when motivated to reduce energy costs, despite

the fact that heating of Anderson is directed to sealing the edge of a laminate and not to directly forming a lid. Applicant also argues a difference between the formed lid of Amberg et al. and the film lid of Heilman et al. and that this would deter one of ordinary skill in the art from making the combination. As the function of Heilman et al. is not destroyed by the combination and the whole structure of Amberg et al. does not have to bodily be incorporated into Heilman to make the extending portion of Heilman opaque, the examiner does not see why one of ordinary skill in the art would not transfer the teaching from Amberg et al. of direct IR heating, when motivated to reduce the number of IR lamps needed in Heilman.

Regarding the double patenting rejection applicant argues that there is no term extending beyond another. Disclaimers also function to maintain common ownership to prevent the enforcement of overlapping claims by different parties.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR of Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William P. Watkins III

WILLIAM P. WATKINS III
PRIMARY EXAMINER

WW/ww
May 15, 2004